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U.S. Patent Application No. 10/664,833
P24138.A05 (S 1010/US)

PATENT APPLICATION
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants	: Bruno BORSOI et al.)	
Appln. No.	: 10/664,833)	Group Art Unit 3728
Docket No.	: P24138)	Examiner Anthony D. Stashick
Customer No.	: 07055)	Confirmation No. 4888
Filed	: September 19, 2003)	
Title	: BOOT FOR SPORTING ACTIVITIES)	

REQUEST FOR WITHDRAWAL OF PREMATURE FINAL REJECTION

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, *Mail Stop AF*
Randolph Building
401 Dulany Street
Alexandria, VA. 22314

Sir:

Pursuant to the guidelines presented in the Manual of Patent Examining Procedure (MPEP), Section 706.07(d), Applicants kindly request that the final rejection issued on October 14, 2005 be withdrawn as being premature. Applicants' reasons are as follows.

The first Office action, of April 27, 2005, included a rejection of dependent claims 6-8 under 35 USC §103(a), based upon a combination of BASSO (U.S. Patent No. 6,405,457) and BARRET (U.S. Patent No. 5,940,990).

On pages 12-13 of their reply filed on July 27, 2005, Applicants traversed that ground of rejection, as well as a rejection of parent claim 1 (and other dependent claims) under 35 USC §102(b) based upon BASSON alone, as follows:

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A distinction between the invention and the boot of BASSO is the arrangement of the keeper(s) on the outer envelope.

In the invention, the boot includes keepers 60, 104 which receive a lace 54, 102 substantially in the area of the heel 4, 83 of the boot on the outer envelope 12, 90. Very differently, in BASSO, the keepers 55, which are not located on the inner envelope 20, are on a removable reinforcing element 30. These keepers are not at all on the outer envelope 10.

At least for this reason, reconsideration and withdrawal of all rejections that are based solely or in part upon BASSO

With regard to the rejection of certain dependent claims based upon a combination of BASSO and BARRET, the drawing figures of BASSO show that the tightening mechanism always includes at least one hook. In the same spirit, the drawing figures of BARRET show the tightening mechanism of the outer envelope always includes rigid rings. In view of the foregoing, Applicants respectfully submit that one skilled in the art would not have been motivated to have made a tightening mechanism that would include loops. In addition, BASSO fails to teach or suggest a rear keeper in the form of a folded strap portion *in the form of a V-shaped loop*, as specified in Applicants' claim 8 (and as shown, for example, in Figs. 1 and 4, and as described in paragraph 0057).

That is, Applicants requested withdrawal of all rejections that were based solely or in part on BASSO for the reason that keepers 55, which are not located on the inner envelope (but on a removable reinforcing element 30), "are not at all on the outer envelope 10." Further, the limitation to which Applicants' arguments were directed appeared in the claims as originally filed, i.e., "the mechanism for tightening the inner envelope further including at least one rear keeper affixed to the outer envelope"; see lines 7-8 of claim 1, as originally filed. In addition, as mentioned above, BASSO fails to teach or suggest a rear keeper in the form of a folded strap portion *in the form of a V-shaped loop*, as specified in Applicants' claim 8, as originally filed.

In the final rejection, the rejection of claims 6-8 on the basis of BASSO and BARRET has been withdrawn, claims 6-8 being newly rejected under 35 USC §103(a), based upon a combination of WO 98/37782 and BARRET. WO '782 does not suffer the aforementioned deficiencies of BASSO and includes a folded strap (although not in the form of a V). Further, claims 6-8 depend from claim 1 and, therefore, incorporate all limitations appearing in parent claim 1, including the limitation from claim 1 quoted above.

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MPEP §706.07(a), entitled "Final Rejection, When Proper on Section Action," explains that "second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement"

Because the limitations noted above, which were brought to the attention of the Examiner in the first Office action, appeared in the claims as originally filed, Applicants submit that the new ground of rejection, viz., the rejection under §103(a) of claims 6-8, based upon a combination of WO '782 and BARRET, was not necessitated by Applicants' amendment. Accordingly, Applicants submit that the finality of the Office action of October 14, 2005 was premature and withdrawal of such finality is kindly requested.

Lastly, by having the finality of the outstanding Office action withdrawn, Applicants can ensure entry of the amendment, concurrently filed herewith, without necessitating the filing of a continuation application or a Request for Continued Examination, which would be consistent with certain of the objectives presented in the USPTO's notice of proposed rule making published in the Federal Register (Vol. 1, No. 1, pages 48-61) on January 3, 2006.

Any comments or questions concerning this application can be directed to the undersigned at the telephone or fax number given below.

Respectfully submitted,
Bruno BORSOI et al.



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